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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/718,883

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Martin Judah Hirsch

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EXAMINER

FERTIG, BRIAN E

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/718,883	<b>Applicant(s)</b> HIRSCH ET AL.	
	<b>Examiner</b> BRIAN FERTIG	<b>Art Unit</b> 3694	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/14/2004</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This action is in response to applicant's filing of 3/11/2008. Claims 1-46 are pending and subject to non-final rejection as set forth below.

#### ***Election/Restrictions***

1. Applicant's election with traverse of inventions I in the reply filed on 3/11/2008 is acknowledged. The traversal is on the ground(s) that Groups II-V do not define separate inventions from Group I, and, in fact, are combinations of the claims included in Group I as per the table provided in Applicant's response. This is persuasive and the Election/Restriction Requirement of 2/11/2008 is, hereby, withdrawn.

#### ***Claim Objections***

2. Claims 2-3,6-7, 25-26, and 29-30 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These claims are directed to non-functional descriptive material. Nonfunctional descriptive material includes but is not limited to music, literary works, and a compilation or mere arrangement of data. This material is nonstatutory when it is claimed as descriptive material, per se (see case law discussion in MPEP § 2106.01). The claims contain limitations to metrics, including data representing the details and performance of stock option funds, including various statistics and performance measures. These limitations serve to define the mere arrangement of data on the administrator's dashboard

interface. As such, the metrics are claimed as descriptive material, per se. These claims have been considered as a whole and the metrics have not been granted patentable weight, since no new and unobvious functional relationship between the printed matter and the substrate exists (see case law discussion in MPEP § 2106.01). The metrics are functionally related to the dashboard as printed matter to display format which is not new as demonstrated by any text displayed on a screen, and particularly by US Patent Application Publication 2001/0023414 for Kumar (see below). As such, these claims fail to further limit the subject matter of previous claims in so far as they are directed wholly toward non-functional descriptive material, which has been granted no patentable weight.

It should be further noted that where claims direct limitations to descriptive material, the particulars of that descriptive material is not given patentable weight for the reasons described above and emphasis is placed on demonstrating the prior art's anticipation of the functional steps and structural aspects of the claimed invention.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8-19 and 32-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 8-19

Claim 8 depends on itself, rendering it and its dependent claims indefinite. For the purposes of examination below, it is assumed that claim 8 is meant to depend from claim 6 as suggested by the parallel claim structure of claims 24-42.

With respect to claims 32-33

Claim 32 depends on itself, rendering it and its dependent claim indefinite. For the purposes of examination below, it is assumed that claim 32 is meant to depend from claim 31 as suggested by the parallel claim structure of claims 1-19.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-8, 11, 13-14, 16-19, 24-31, 34, 36-37, and 39-42 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Application Publication 2001/0023414 for Kumar (Kumar).

With respect to claims 1 and 24

Kumar teaches:

A method and system for providing centralized employee stock plan administration, comprising and capable of:

receiving identification information from a user (i.e.

username and password, see par 92);

determining the user's entitlement to available features based on the identification information (see par 98, note that Kumar teaches a portal through which a user accesses a number of different features and services. The entitlement to access to those features is determined by the user's username and password. Note also the Password-All feature introduced in par 64 and further disclosed throughout Kumar); and

displaying an administrator's dashboard interface screen including therein an administrator's dashboard interface (i.e. multiple point-of-access summary interface, see par 178-179, the Multiple Point-of Access Summary interface section, generally, and fig 11- 15) that provides at metrics according to the user's entitlement, the metric associated with at least one employee stock plan of a company, the metric providing users with key numerical data regarding at least one employee stock plan (see par 179, 188-189 and fig 11-15, note that key numerical data with respect to stocks and other financial information is displayed).

With respect to claims 2 and 25

Kumar teaches:

comprising and capable of displaying an administrator's dashboard interface providing at least one metric associated with at least one employee stock plan, the metric comprising at least one of processing

statistics for workflow requests, processing statistics for reporting requests, plan activity for particular employee stock plans, and plan statistics for particular stock plans (see par 179, 188-189 and fig 11-15, note that plan activity and statistics are displayed related to various portfolios, see also Claim Objections above)

With respect to claims 3 and 26

Kumar teaches:

wherein the plan activity metric comprises data pertaining to at least one of the number of shares of company stock exercised, vested, expired, settled, and released, and wherein the plan statistics comprises data pertaining to at least one of the number of active participants, outstanding grants, outstanding options, outstanding plan value, outstanding shares, and total elections (see par 179, 188-189 and fig 11-15, note that plan activity and statistics are displayed related to various portfolios, see also Claim Objections above)

With respect to claims 4 and 27

Kumar teaches:

comprising and capable of displaying an administrator's dashboard interface providing the user with at least one feature selected from a group consisting of alerts, contact information, and market information (see par 179, 188-196 and fig 11-15, note that alerts, contact information, and market information are disclosed in so far as Account Alert, Bill Payment,

Transaction Center, Communications, and Portfolio Tracker modules are taught)

With respect to claims 5 and 28

Kumar teaches:

comprising and capable of determining, based on the identification information, the user's company specific entitlement to available features (see par 62 and 64, note that the portal acts as an ISP, as such the particular well known Internet services and other unique services are determined by the company operating the ISP which whom the user is affiliated).

With respect to claims 6 and 29

Kumar teaches:

Comprising and capable of displaying an administrator's dashboard interface screen including therein at least one of a plurality of available key business function navigation elements displayed according to user's entitlements, the key business function navigation elements allowing users to access therewith key business functions (see par 179, 188-196 and fig 11-15, note that access to key business functions like Account Alert, Net Worth, Bill Payment, Calendar, etc are disclosed, see also Claim Objections above)

With respect to claims 7 and 30

Kumar teaches:



wherein the key business function navigation elements are displayed consistently within each of the key business function interface screens (see fig 11-15, note the consistency of display formatting in so far as each element is displayed consistently in a box with a heading of the same font and heading bar with uniform indicia, see also Claim Objections above).

With respect to claim 8 and 31

Kumar teaches:

wherein the key business navigation elements allows users to access key business functions comprising at least one of an administrator's dashboard function, a participant inquiry function, a workflow function, a reporting function, a site administration function, a file exchange function, a client profile function, and an events calendar function (see par 179, 188-196 and fig 11-15, note that that these function are disclosed in so far as a dashboard, communication, bill payment, calendar, bookmark, portfolio, and travel planner modules are taught)

With respect to claims 11 and 34

Kumar teaches:

comprising and capable of displaying a workflow interface screen in response to a user's navigation request, the workflow interface screen providing a status summary for workflow requests (i.e. displaying calendar utility, see par 198-203, note that summaries by day, week, month and year are available)

With respect to claims 13 and 36

Kumar teaches:

comprising and capable of displaying a workflow interface screen in response to a user's navigation request, the workflow interface screen providing a status summary for workflow requests submitted by all users assigned a specific role (see par 198-203, note that summaries of entries on a category basis are disclosed).

With respect to claims 14 and 37

Kumar teaches:

comprising and capable of:

displaying a workflow interface screen including form elements therein allowing a user to submit a particular type of a new workflow request (see par 200, note the ability to add items);

receiving a new workflow request (see par 200); and

displaying a new workflow request interface screen particular to the type of workflow request received, the workflow request interface screen including form elements therein allowing the user to specify details of the request (see par 200 in combination with 201).

With respect to claims 16 and 39

Kumar teaches:

comprising and capable of displaying a workflow interface screen

including form elements therein allowing a user to submit a particular type

of new workflow request selected from a group consisting of a general change request for a participant, a request for a participant demographic change, a grant change request, a request to indicate participant termination, a request for a participant tax profile change, a request for an exercise revision, a request to block users from the system, and a request to change insider status (see par 200 and 201, note that the item can be and appointment or task and may be assigned to a category).

With respect to claims 17 and 40

Kumar teaches:

the workflow interface screen including therein at least one navigation element associated with a particular workflow requests listed therein allowing the user to request a workflow case summary (see par 202, note that a summary view is available and is available via a navigation element in so far as it is part of a secondary interface, see par 198).

With respect to claims 18 and 41

Kumar teaches:

comprising and capable of displaying a plan reporting interface screen in response to a user's navigation request (i.e. bill payment center, see par 233), the plan reporting interface screen allowing the user to request a report based on at least one of user defined criteria and a report template of a plurality of available templates (see par 234, note that bills may be displayed by various categories, by various sortings of dates, and

amounts and payees), and allowing the user to view reports (see par 233 and fig 18).

With respect to claims 19 and 42

Kumar teaches:

wherein the plan reporting interface screen includes therein navigation elements allowing a user to navigate to an interface screen selected from a group consisting of a run report interface screen allowing a user to request a report therewith, a report queue interface screen providing a list of active, pending, scheduled, and failed reports, and a finished report interface screen listing reports that the user is entitled to view, the finished report interface screen including navigation elements therein allowing the user to request an action with respect to the listed reports (see par 259-261 and fig 21, note that bill status may be listed in a number of different states including pending, complete, NSF, or rejected. Note further the navigation element that permits the user to request an action to list additional bills).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 9-10, 12, 32-33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar.

With respect to claims 9 and 32

Kumar teaches comprising and capable of:

displaying a participant inquiry interface screen in response to a user's navigation request (see par 198, note that secondary interfaces are invoked as a result of user interaction with a module), the participant inquiry interface screen including form elements therein allowing the user to specify search criteria to search for participants of at least one employee stock plan (see par 79-81, and 94 note the teaching of search functionality within the portal);

receiving therewith the search criteria from the user (i.e. accept input or enter search criteria see par 79-80, and 94); and

displaying a search result interface screen listing participants matching the user's search criteria, the search result interface screen including at least one navigation element therein allowing the user to access participant information for a particular participant (see par 80 and 94, note that the extracted information may be in the form of urls, thereby allowing user to access information via a navigation element).

Kumar does not explicitly teach providing the search functionality within the participant inquiry screen.

It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have provided the search capability of Kumar to the particular interfaces of Kumar in order to have provided users with more direct and convenient access to the search functionality as suggested by Kumar in so far as Kumar teaches a portal system for aggregating and simplifying access to user data.

With respect to claims 10 and 33

Kumar teaches:

comprising and capable of:

receiving a request for a participant profile for a particular participant (i.e. selecting transaction module, see par 198 and 204);  
and

displaying a participant profile interface screen in response thereto, the participant profile interface screen providing personal

information relating to the participant, and including therein navigation elements allowing a user to access at least one of administration data, comments, registration data, leave of absence data, participant plan information, and trade summaries for the selected participant (see par 204 and fig 13, note display of transactions).

(see rationale supporting obviousness and motivation to combine of claims 9 and 32 above)

With respect to claims 12 and 35

Kumar teaches:

comprising and capable of:

displaying a workflow interface screen (i.e. displaying calendar utility, see par 198) including therein form elements allowing a user to specify search criteria to search for workflow requests (see par 79-81, and 94 note the teaching of search functionality within the portal);

receiving therewith search criteria from the user (i.e. accept input or enter search criteria see par 79-80, and 94); and

displaying a search result interface screen listing workflow requests matching the user's search criteria, the search result interface screen including at least one navigation element therein allowing the user to access a case summary for a particular

workflow request (see par 80 and 94, note that the extracted information may be in the form of urls, thereby allowing user to access information via a navigation element).

Kumar does not explicitly teach providing the search functionality within the workflow interface screen.

(see rationale supporting obviousness and motivation to combine of claims 9 and 32 above)

10. Claims 15, 20-23, 38, and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar in view of Official Notice.

With respect to claims 15 and 38

Kumar does not explicitly teach:

wherein the workflow interface screen includes therein a participant ID form element requiring the user to input a participant's identification number in order to initiate a new workflow request for a participant, the form elements included in the new workflow request interface screen automatically populated based on the participant's identification number

Examiner takes Official Notice that it was well known in the art to provide 'auto-fill' features to forms. For example, forms for which the system already contains data, such as shipping address or phone number, routinely automatically fill in this information, for example, in the check out window of an e-commerce site in order to improve the speed and accuracy of the online ordering process.



It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have provided the 'auto-fill' feature taught by Official Notice to the workflow interface of Kumar in order to' have increased the speed and accuracy of filling out the new request form.

With respect to claims 20-23 and 43-46

See the rejections of claims 1-19 and 24-42 above, substantially teaching the disclosure of Kumar with respect the limitations of claims 20-23 and 43-46 in light of applicant's argument that these claims are combinations of the limitations recited in rejected claims 1-19 and 24-42 above.

***Inquiry***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN FERTIG whose telephone number is (571)270-5131. The examiner can normally be reached on Monday - Friday 8:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3694

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B.F./

/Mary Cheung/  
Primary Examiner, Art Unit 3694